

REMARKS

Claims 1, 3, 5-7, 10, 11, 13-21, 23-31, 34-38, and 41-44 are pending in this application. By this Amendment, claims 1 and 10 are amended. Non-elected claims 17-20 and 24-29 have been withdrawn from consideration by the Examiner. The claim status identifier for claim 6 has been amended in view of the Office Action's suggestion. Support for the amendments may be found, for example, in the original claims and the specification at paragraph [0073]. No new matter is added.

Entry of the amendments is proper under 37 CFR §1.116 because the amendments: (a) place the application in condition for allowance for the reasons discussed herein; (b) do not raise any new issue requiring further search and/or consideration as the amendments clarify issues previously discussed throughout prosecution; (c) satisfy a requirement of form asserted in the previous Office Action; (d) do not present any additional claims without canceling a corresponding number of finally rejected claims; and (e) place the application in better form for appeal, should an appeal be necessary. The amendments are necessary and were not earlier presented because they are made in response to arguments raised in the final rejection. Entry of the amendments is thus respectfully requested.

In view of the following remarks, Applicants respectfully request reconsideration and allowance.

I. Personal Interview

The courtesies extended to Applicants' representative by Examiners Heincer and Salvitti at the personal interview held August 23, 2010 are appreciated. The reasons presented at the interviews as warranting favorable action are incorporated into the remarks below, which constitute Applicants' record of the interview.

II. Rejections Under 35 U.S.C. §112

The Office Action rejects claims 39 and 40 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Applicants respectfully traverse the rejection.

The subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement. MPEP §2163.02. The fundamental factual inquiry is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed. *See, e.g., Vas-Cath, Inc.*, 935 F.2d at 1563-64, 19 USPQ2d at 1117. To comply with the written description requirement of 35 U.S.C. 112, ¶ 1, each claim limitation must be expressly, implicitly, or inherently supported in the originally filed disclosure. When an explicit limitation in a claim "is not present in the written description whose benefit is sought it must be shown that a person of ordinary skill would have understood, at the time the patent application was filed, that the description requires that limitation." *Hyatt v. Boone*, 146 F.3d 1348, 1353, 47 USPQ2d 1128, 1131 (Fed. Cir. 1998). *See also In re Wright*, 866 F.2d 422, 425, 9 USPQ2d 1649, 1651 (Fed. Cir. 1989) (Original specification for method of forming images using photosensitive microcapsules which describes removal of microcapsules from surface and warns that capsules not be disturbed prior to formation of image, unequivocally teaches absence of permanently fixed microcapsules and supports amended language of claims requiring that microcapsules be "not permanently fixed" to underlying surface, and therefore meets description requirement of 35 U.S.C. 112.). MPEP §2163.

The examiner has the initial burden of presenting evidence or reasoning to explain why persons skilled in the art would not recognize in the original disclosure a description of the invention defined by the claims. MPEP §2163. The Office Action has failed to meet its

burden, because the specification provides an example that would teach a person of ordinary skill in the art in what way to adjust the pH to achieve aggregation.

Claims 39 and 40 recite "freezing aggregation of the particles in the dispersion by pH adjustment once at a desired aggregated particle size." The specification describes an example wherein the particles reach their desired size, adjustment of the pH with sodium hydroxide, adjustment of the pH with nitric acid, leading to aggregation of the particles. *See* specification at paragraph [0077]. The specification gives specific examples of how to adjust the pH and which compounds can adjust the pH.

Accordingly, Applicants respectfully request withdrawal of the rejection.

III. Rejections Under 35 U.S.C. §103(a)

The Office Action rejects claims 1, 3, 5-7, 10, 11, 13-16, 21, 23, 30, 31, and 34-44 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,210,853 to Patel et al. ("Patel") in view of U.S. Patent Application Publication No. 2002/0107306 to Wang et al. ("Wang"). Applicants respectfully traverse the rejection.

Claims 1 and 10 would not have been rendered obvious by Patel and Wang. The Office Action, on page 2, acknowledges that Patel does not disclose (1) an "epoxy resin" as recited in claims 1 and 10, (2) the elected polyfunctional amine as a curing agent, or (3) "adding at least one curing agent to the coalesced particles" as recited in claim 1 or "mixing curable resin particles comprising an epoxy resin and at least one curing agent with an aggregating agent in an aqueous dispersion" as recited in claim 10. The Office Action relies on Wang to make up for these deficiencies of Patel.

The Office Action asserts that Wang teaches making epoxy particles in an aqueous dispersion with an amino functional group on a reactive cross linker added after coalescing. The Office Action also asserts that Patel and Wang are analogous art. However, modifying Patel with Wang would render Patel unsatisfactory for its intended purpose.

Independent claim 1 recites "mixing curable resin particles comprising an epoxy resin and an aggregating agent in an aqueous dispersion, the aqueous dispersion comprising a surfactant." Independent claim 10 recites "mixing curable resin particles comprising an epoxy resin with an aggregating agent in an aqueous dispersion, the aqueous dispersion comprising a surfactant." As described in the specification, the aqueous dispersion recited in the claims is a surfactant solution. *See, e.g.*, specification at paragraph [0073]. One of ordinary skill in the art would have understood that an aqueous dispersion of the claimed emulsion aggregation process would have been a surfactant solution.¹ For example, use of a surfactant solution is described in the examples in the specification. The amendments to claims 1 and 10 simply clarify the aqueous dispersion recited in the claims.

Patel teaches preparation of a "surfactant free latex wherein resin particles contained therein are aggregated and coalesced with a colorant." Patel at col. 1, lines 30-33. Because the process of Patel is surfactant free, modifying Patel to include a surfactant would render Patel unsuitable for its intended purpose. It is well settled that if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *See* MPEP 2143.01 (V), citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Therefore, claims 1 and 10 would not have been rendered obvious by the asserted combination.

¹ The Patent and Trademark Office ("PTO") determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art." *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). Indeed, the rules of the PTO require that application claims must "conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description. 37 CFR 1.75(d)(1).

For at least the reasons above, the combination of Patel and Wang would not have rendered obvious claims 1 and 10. Claims 3, 5-7, 11, 13-16, 21, 23, 30, 31, and 34-44 variously depend from either claim 1 or claim 10 and, thus, also would not have been rendered obvious by the asserted combination. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection.

IV. Rejoinder

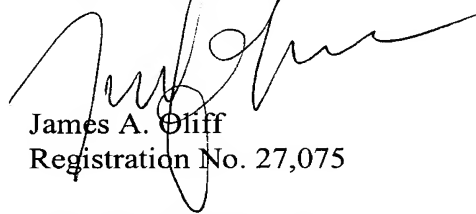
Applicants also respectfully request rejoinder of non-elected method claims 17-20 and 24-29. Because claims 17-20 and 24-29 depend from and/or otherwise include all limitations of either claim 1 or claim 10, Applicants respectfully request that upon allowance of claims 1 and 10, claims 17-20 and 24-29 be rejoined as required under MPEP §821.04(a). Because claims 1 and 10 are believed to be allowable for at least the reasons presented above, Applicants respectfully request withdrawal of the Restriction Requirement and rejoinder of claims 17-20 and 24-29.

V. Conclusion

In view of the foregoing, Applicants respectfully submit that this application is in condition for allowance. Applicants earnestly solicit favorable reconsideration and prompt allowance of the application.

Should the Examiner believe that anything further would be desirable to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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